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KIMBERLY-CLARK WORLDWIDE, INC.			COLE, ELIZABETH M	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/680,968  
Filing Date: October 07, 2003  
Appellant(s): ZEHNER ET AL.

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Randall Fieldhack  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 14, 2006 appealing from the Office action mailed February 14, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The obviousness-type double patenting rejection is withdrawn.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

EP 650,714	Coles	5-1995
6,287,288	Osborn	9-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification as originally filed does not enable one skilled in the art to make the claimed invention because it does not disclose what is meant by activation, or how activation is achieved. In determining whether or not the disclosure is enabled, the following factors must be considered: A) The breadth of the claims; B) The nature of the invention; C) The state of the prior art; D) The level of one of ordinary skill in the art; E) The level of predictability in the art; F) The amount of direction provided by the inventor; G) The existence of working examples; and H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

With regard to the breadth of the claims, claim 1 recites an impermeable backing, the claimed liner composite and an absorbent material between the liner composite and the backing. Claim 18, recites the liner composite, but does not include the backing or absorbent core. None of the claims are drawn to a garment or recite a garment structure. The claims therefore encompass any disposable absorbent material having the claimed layers, including pads which could be used as floor mats, pads which absorb meat juices, absorbent wipes and towels and pads which are used for hygiene without being worn per se, but rather are affixed to the user's garment.

With regard to the nature of the invention, the invention is drawn to a disposable absorbent material. It is not drawn to a garment, diaper, training pant, etc. The disposable absorbent material can take on a non planar shape when it is "activated".

With regard to the state of the prior art, as shown by the prior art employed in the art rejections below, it is known in the art of disposable absorbent materials to form shaped materials which comprise combinations of elastic layers with other materials, in order to provide shape and elasticity to the absorbent materials which can improve the fit of garments which comprise the elastic layers as part of the absorbent article.

With regard to the level of ordinary skill in the art, as shown by Coles, it was known to combine an elastic material with a non-elastic material in order to form a gathered, elastic material which can be useful in forming garments such as diapers. As shown by Osborn, it was also known to form elastic layers by combining an elastic layer with an extensible layer which allow extension of the elastic layer to a certain point but no further without substantial force.

With regard to the level of predictability in the art, it can be predicted that combining an elastic layer with an extensible but not elastic layer will produce a material which can extend to a certain degree but that the extensible layer will generally act as a stop on the elastic layer. It is also predictable that when an elastic layer is bonded to a non elastic layer when the elastic is under tension that the thus combined material when released from tension will form a gathered material.

With regard the level of guidance provided by the specification, the specification provides a statement that "activation" of the material occurs when the material is "donned" or during use, but does not provide guidance as to how to activate the claimed invention which is not a garment and which therefore cannot be "donned". The specification does not provide guidance as to how to activate the claimed composite in terms of in what direction the material would have to be stretched or how much force would have to be applied.

With regard to working examples, the specification does not include working examples.

With regard to whether undue experimentation would be required. since the specification provides only the general guidance that activation occurs during donning of the garment and the instant claims are not drawn to a garment and do not recite any garment structure which would enable the claimed absorbent material to be worn, and since the specification does not provide teaching as to how to activate a material such as the claimed invention which is not able to be worn as a garment, undue experimentation would be necessary.

Therefore, looking at the above factors, the claimed invention is not enabled by the specification since the only method of activation set forth in the specification is to activate by donning a garment which comprises the elastic, but the instant claims are not drawn to a garment and therefore cannot be worn or donned. The specification does not provide working examples, and does not provide teachings regarding what treatment or method step would be necessary to activate the claimed layered material. While it is generally known to bond elastic layers with non-elastic which predictably provide stretchable materials which may also form gathers when not being stretched, and which have a limit to how far they can be stretched, the person of skill in this art would not be able to make the claimed invention which is not drawn to a garment since the specification teaches activation by putting on a garment comprising the elastic since the instant claims are not drawn to a garment.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In independent claims 1 and 18, it is not clear what is meant by "activation". How is the liner material activated? Also, it is not clear what is meant by "adapted to", in that the structural or other changes which adapt the liner are not set forth in the claim. Also, in claims 1 and 18, it is not clear what is meant by the limitation that the elastic is non-tensioned. Does this mean that the elastic is associated with the fluid permeable layer while it is in a non-tensioned state or does it mean that the elastic is never under tension, or does it refer to the state of the elastic before

“activation”? Also in claims 1 and 18, it is not clear what the claimed extensibility is in reaction to, i.e., what force is applied to extend the liner composite at least 25%? In claims 2 and 21, it is not clear what is meant by the limitation “the three-dimensional configuration is a barrier element”. Does this mean that the configuration comprises a barrier element or that it forms a barrier element, and if it means it forms a barrier element, where is the barrier element in relation to the other portions of the absorbent article. In claims 4, and 13 it is not clear what is meant by “associated with and superposed on... to thereby form a periphery”. Does this mean that the size of the liner composite is the same as the size of the outer cover? In claim 6, it is noted that neither claim 1 nor claim 5 recite a leg structure, so it is not clear where the leg portion of the absorbent article is in relation to the rest of the absorbent article. In claims 7 and 24, 26, it is not clear how the barrier element can be liquid impermeable since the barrier element is formed from the three-dimensional liner composite which is described as being fluid permeable. In claim 8, it is not clear what the barrier element is laterally oriented with regard to, in other words, what is the reference point which the barrier element is lateral to? In claim 9, it is not clear where the waist elastic is in relation to the claimed absorbent article. In claim 19, it is not clear how the barrier element can be liquid impermeable since it is formed by the liner composite which is taught as being permeable in claim 1. In claims 11 and 27, it is not clear what the structure of a fit element is. How does claim 11 further limit the independent claim? The structure of the fit element is not set forth, and the structure of the absorbent article comprising the fit element is not set forth.



Claims 2-17, 19-31 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: how the barrier element, leg elastic, leg, waist, waist band and fit elements are disposed in the structure of the absorbent article. The independent claims recite an impervious layer, (called the outer cover), the absorbent core and the permeable liner. The dependent claims state various elements , (i.e., barrier, leg cuff, waist band, fit element), that the liner composite "is", but do not set forth the actual structure of the absorbent article.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coles, EP 650,714, alone or in the alternative, in view of Osborn III et al, U.S. Patent No. 6,287,288. Coles discloses an absorbent article which comprises a topsheet a back sheet and an absorbent core. The topsheet is permeable. The absorbent article has an elastic composite which can be attached to either the topsheet or the backsheet. The elastic composite is formed by attaching the elastic in a relaxed state, (which is equated to the claimed non-tensioned state) to another layer such as a nonwoven fabric, (which would be permeable). See abstract and col. 8, lines 6-15. The elastic composite is then activated by stretching it to extend the other layer and activate the elastic layer. See col., 4, lines 14-26. The activated elastic composite then gathers the portions of the absorbent article to which it is attached, which corresponds to the claimed formation of the three dimensional configuration. See col. 4, lines 35-55. The elastic composite can be attached to leg portions, barrier cuffs or waist bands of the absorbent article.

See col. 6, lines 9-24. While Coles does not disclose the retraction capability, since Coles teaches forming an elastic composite which can be applied to various regions of the absorbent article where elasticity is desired, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the particular degree of elasticity and thus retraction capability desired in the finished article, especially since the layer to which the elastic layer is attached is much less extensible than the elastic layer. With regard to the limitation that the other layer to which the elastic layer is bonded is extensible, it is noted the Coles discloses that the layer is generally inextensible and defines this as being able to extend 5% at a force of between 0.5 and 5 N/cm. The examiner is not able to determine whether this would anticipate the claimed degree of extensibility since the force applied is not set forth in the instant claims. Therefore, in the alternative, if the second layer of Coles is considered to be inextensible, Osborn teaches employing an extensible material as either the topsheet, the backsheet or both. See col. 13, lines 57-67. The extensible topsheet and/or backsheet enhances the comfort of the wearer of the absorbent article. Therefore, it would have been obvious to one of ordinary skill in the art to have employed an extensible topsheet or backsheet in the absorbent article of Coles, motivated by the expectation that this would enhance the comfort of the wearer of the absorbent article. The extensible topsheet would correspond to the claimed extensible, permeable liner material which is associated with the elastic material since the elastic composite of Coles can be bonded to regions of the topsheet or backsheet of an absorbent article.

**(10) Response to Argument**

With regard to the 112 1<sup>st</sup> paragraph rejection, Appellant argues that the claims are enabled because what is meant by activation and how activation is achieved is discussed throughout the specification. However, the portion of the specification cited by Appellant discusses what happens after activation, (i.e., the material takes on a three-dimensional shape), but does not state what the actual steps required for activation are. Specifically, with regard to the claimed invention, since no garment structure is recited, and the material is not even referred to as a garment in the preamble of the claim, the teaching that activation occurs when being donned or while in use by a wearer does not enable one of skill in the art to make the claimed invention since the claimed invention is not a garment and cannot be worn. Appellant also argues that the specification also discusses the retraction capability differential. However, this argument is not directed to how to activate the claimed layered structure, but instead recites a further feature of the claimed invention

With regard to the 112 2<sup>nd</sup> rejection, Appellant asserts the same arguments with regard to the rejection of “activation” under 112 2<sup>nd</sup> as were asserted with regard to the rejection under 112 1<sup>st</sup>. However, the metes and bounds of the claim are not clear because it is not clear what degree of force would have to be applied to provide activation to the claimed composite material.

With regard to the limitation “adapted to”, Appellant argues that the sub parts labeled as (i) and (ii) make it clear that it is the interaction of the extensible liquid

impermeable outer cover material and the non-tensioned elastic and the relationship of these materials that upon activation they will have a retraction capability differential of at least 10% and will attain a three dimensional configuration. However, this argument does not address how the components are adapted, i.e., how are they changed. To recite that an element is adapted implies that the element has been modified or changed beyond the element simply being present. The relationship between the two components is not an adaptation of the components, but rather sets forth their interaction. However, the claim recites that the two components are adapted to interact in a particular way upon activation, but does not set forth any structure as how the components are adapted.

With regard to non-tensioned, Appellant argues that this term is used throughout the specification. However, this does not address the merits of the rejection which state that it is not clear what is meant by non-tensioned. Appellant states that non-tensioned refers to the elastic state before activation. However, this language is not present in the claims. Further, it is noted that the elastic is still referred to as "non-tensioned" after activation when the composite liner has assumed the three-dimensional configuration.

With regard to the claimed extensibility, Appellant refers to the specification and the statement that it is desirable that the liner material be capable of extending no less than 25%. However, extensibility must be defined as the degree of extension in response to a particular force. Without knowing the force applied to extend the material the recitation of a particular percentage of extensibility is incomplete and therefore indefinite. The metes and bounds of the claim are unclear and comparison cannot be

made to the prior art. For example, the primary reference employed in the art rejection, teaches "limited extensibility" which it defines as not more than 5% extension in response to a force of 0.5 and 5 N/cm. Since the instant claims do not similarly define the extensibility in terms of force, they are indefinite and cannot be compared with the prior art to determine whether or not the prior art would have the claimed degree of extensibility. The claims do not recite the degree of force applied, and therefore the claims are indefinite

With regard to claim 6, Appellant points to the specification. However, claim 6 recites a leg elastic but does not disclose any leg structure, so the claimed structure is not clear. Similarly, with regard to claim 8 and 9, Applicant points to the specification. However, while the claims are read in light of the specification, limitations are not read from the specification into the claims. A claim which recites the lateral centerline needs to have first positively recited a lateral centerline. A claim which refers to a waist elastic need to have recited that a waist is present. With regard to the fit element, again, while the claims are interpreted in light of the specification, the basic structure of the article being claimed needs to be set forth in the claim in order for the metes and bounds of the claim to be set forth and in order for the claim to be definite.

With regard to the rejection omitting essential elements from the claims, the claims are required to particularly point out and distinctly claim the invention. To recite that the non-tensioned elastic is "associated" with the cover does not particularly point out and distinctly claim the invention because the structure being claimed is not clear.

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While the claims are understood and interpreted in light of the specification, the claims still need to recite the basic structures which are present in the claimed material.

With regard to the obviousness-type double patenting rejection, this rejection has been withdrawn.

With regard to the art rejection, Appellant argues that Coles clearly fails to teach or suggest an extensible liquid permeable outer cover. However, Coles teaches that the outer cover has an extensibility which is defined as being able to extend 5% at a force of between 0.5 and 5 N/cm. As set forth with regard to the 112 second paragraph rejections above, the extensibility of the claimed material is not clearly set forth.

Therefore, the examiner is not able to determine whether the material of Coles would be considered extensible as the term is used in the instant claims. Since the material of Coles does extend 5% at a force of between 0.5-5 N/cm, it is clear that the material of Coles is not inextensible in an absolute sense. Therefore, the Coles structure does teach an extensible permeable layer. Applicant argues that the instant claims require an extensibility of no less than 10%. However, the force which is applied to achieve the extensibility is not set forth.

Appellant argues that the specification provides a formula at page 5 regarding the extensibility. However, the formula at page 5 relates to how to calculate how much the material has been extended using the starting and ending length, but does not disclose the force used to elongate or extend the material.

With regard to the combination of Coles and Osborn, Appellant argues that the extensible layer of Osborn could not be substituted for the less extensible layer of Coles because Coles requires the less extensible layer to be permanently elongated so that pleats are formed. However, Coles merely requires that there be a difference in extensibility of the two layers so that the less extensible layer is extended so as to be permanently elongated. Therefore, the extensible layer of Osborn could be combined with the Coles structure in order to improve the comfort of the wearer of the absorbent article by improving the fit, while still maintaining the ability of the extensible layer to be extended to a degree that it is permanently extended in order to form pleats.

Appellant asserts that Coles differs from the claimed invention by only the single difference of using an inextensible rather than an extensible fluid permeable material. However, as set forth above, Coles does not teach an absolutely inextensible material, but rather teaches one which has a particular degree of extensibility. Since the instant claims are indefinite due to their incompleteness since the extensibility is not set forth in terms of the force applied, it is not clear whether the layer of Coles is extensible as the instant claims intend to use the word. However, it is also clear that the material of Coles is not inextensible in any absolute sense and that it is impossible to fully compare the claimed invention to prior art due to the indefiniteness of the claims. Finally, even if the material of Coles does not teach a layer which has the claimed extensibility, Osborn provides a motivation for bonding an elastic layer to a more extensible layer in order to improve the fit and comfort of garments which comprise the composite material. As

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long as there was a difference in the extensibility of the two materials, a gathered material would still be formed upon elongation of the composite material as taught by Coles.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Elizabeth M. Cole

Conferees:

Terrel Morris

Jennifer Michener

